



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 037267/0138

# 7  
05-92-03  
S I

Applicant: Kaniada NAKAYASU  
Title: SYSTEM FOR MONITORING CDMA-TYPE MOBILE TERMINAL  
AND METHOD OF DOING THE SAME  
Serial No. 09/866,796  
Filed: May 30, 2001  
Examiner: Unknown  
Art Unit: 2661

RECEIVED

MAY 14 2003

Technology Center 2600

**INFORMATION DISCLOSURE STATEMENT  
UNDER 37 CFR §1.56 and 37 CFR §1.97**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Sir:

Submitted herewith on Form PTO-SB08 is a list of documents known to Applicant in order to comply with Applicant's duty of disclosure pursuant to 37 CFR 1.56. A copy of each listed document is being submitted to comply with the provisions of 37 CFR 1.97 and 1.98.

The submission of any document herewith, which is not a statutory bar, is not intended as an admission that such document constitutes prior art against the claims of the present application or that such document is considered material to patentability as defined in 37 CFR §1.56(b). Applicant does not waive any rights to take any action which would be appropriate to antedate or otherwise remove as a competent reference any documents which is determined to be a prima facie prior art reference against the claims of the present application.

**TIMING OF THE DISCLOSURE**

The instant Information Disclosure Statement is believed to be filed in accordance with 37 C.F.R. 1.97(b), prior to the mailing date of a first Office Action on the merits (first scenario). If that is not the case, such as in a second scenario in which a first Office Action on the merits has been mailed before the filing of the instant Information Disclosure Statement, then either a certification or fee is required, and a certification is provided below. If neither of the first or second scenarios is the case, such as if a final Office Action or a notice of allowance has been mailed by the PTO (third scenario), then both a certification and fee are required, and in that case a certification is provided below and also the PTO is authorized to obtain the necessary fee to have the instant IDS considered, from Foley & Lardner Deposit Account #19-0741.

**CERTIFICATION**

The undersigned hereby certifies in accordance with 37 C.F.R. §1.97(e)(1) that each item of information contained in this Information Disclosure Statement was first cited in a communication from a foreign patent office in a counterpart foreign application not more than three (3) months prior to the filing of this Statement.

**RELEVANCE OF EACH DOCUMENT**

A translation of a portion of a Korean Office Action that issued March 25, 2003 with respect to a counterpart Korean patent application is provided below.

"The invention demonstrates no inventive step according to [Japan Patent Law] Article 29, Section 2.

Described in all of the claims of the present invention is a system to monitor a CDMA-type mobile terminal device that is configured by a base station system, a network, and a monitoring device that monitors mobile terminals by connecting to the

aforementioned network, and that accesses the terminal via the base station or the network.

Described in the cited literature (IPO Patent 00-7398, February 10, 2000) is a peripheral device control method that includes a subscriber station administration device that conducts administration by controlling subscriber terminals including at least one peripheral device.

When comparing the present invention with that of the cited literature, the mobile communications configuration that includes a specified administration device to administer and control terminal devices is similar. However, there is the difference that in the invention of the cited literature the aforementioned management device is connected via a base station control device, but in the present invention the connection is possible via a base station and a network. Nonetheless, there is no particular technical difficulty in changing the configuration this way. Therefore, a person with ordinary knowledge in the applicable technical field would have no difficulty making the configuration of the present invention by making suitable design changes to the invention of the cited literature. Moreover, the effect of the present invention could be fully anticipated from the effect of the aforementioned invention of the cited literature.

Consequently, a person skilled in the art could easily invent the present invention from well-known technology (Japan Patent Law Article 29, Section 2)."

A translation of a portion of a Japanese Office Action that issued April 1, 2003 with respect to a counterpart Japanese patent application is provided below.

#### "Comments

In the applicant's opinion statement, the applicant claims that a comparison of Publication 1 (Japanese Unexamined Patent Application Publication H2000-091982) and Publication 2 (Japanese Unexamined Patent Application Publication H2000-023230) shows that "the authentication check of Publication 1 and Publication 2 are clearly different from the authentication check of this invention in that nothing other than the pre-registered CDMA mobile device is authenticated."

However, according to Japanese Unexamined Patent Application Publication H05-336108 (See Figure 5, column 3, lines 43-44, "wireless terminal authentication with respect to the wireless terminal 1, which placed the call ... compares ... in wireless base station 7, the wireless terminal code key in the database...), Japanese Unexamined Patent Application Publication 2000-032560 (See Figure 2, column 4, lines 4-7 "authentication request from the base station to the mobile station ... at the base station ... the authentication key is compared"), it is well known that, "the authentication check does not check anything but the pre-registered mobile device" and the fact that the CDMA mobile unit in Publication 1 performs this authentication check is no more than a design matter that could have been easily devised by the party in question.

Thus, the invention described in Claims 1-10 of this application could have been easily devised by the party in question based on the Publications 1-3."

Applicant's statements regarding the Korean and Japanese Office Actions are based on a partial translation that Applicant's representative obtained. These statements should in no way be considered as an agreement by Applicant with, or an admission of, which is asserted in the Korean and Japanese Office Actions.

Applicant respectfully request that the listed documents be considered by the Examiner and formally be made of record in the present application and that an initialed copy of Form-SB08 be returned in accordance with MPEP §609.

Respectfully submitted,

13 May, 2003  
Date

Phillip J. Articola  
Phillip J. Articola  
Registration No. 38,819

FOLEY & LARDNER  
Washington Harbour  
3000 K Street, N.W., Suite 500  
Washington, D.C. 20007-5109  
Telephone: (202) 672-5300  
Facsimile: (202) 672-5399

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Substitute for form 1449B/PTO <b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> Date Submitted: May 13, 2003 (use as many sheets as necessary)				<b>Complete if Known</b>	
Application Number				09/866,796	
Filing Date				05/30/2001	
First Named Inventor				Kanada NAKAYASU	
Group Art Unit				2661	
Examiner Name				Unknown	
Attorney Docket Number				037267-0138	

[illegible][illegible]

NON PATENT LITERATURE DOCUMENTS			
Examiner Initials*	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.) date, page(s), volume-issue number(s), publisher, city and/or country where published.	T <sup>o</sup>

Examiner Signature		Date Considered	
-----------------------	--	--------------------	--

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<sup>1</sup> Unique citation designation number. <sup>2</sup>See attached Kinds of U.S. Patent Documents. <sup>3</sup>Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>4</sup>For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document.

Standard ST.3). For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document.  
 5Standard document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. 6Applicant is to place a check mark here if English language Translation is attached.

**Burden Hour Statement:** This form is estimated to take 2.0 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, PO Box 1450, Alexandria, Virginia 22313-1450. **DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO:** Commissioner for Patents, PO Box 1450, Alexandria, Virginia 22313-1450.